LIBRARY
PREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
JAN 8 1970
JOHN F. DAVIS, CLERK

No. 941

In the
Supreme Court of the United States
OCTOBER TERM, 1969

FRIEND AND COMPANY
and WILBER H. FRIEND,
Petitioners,

vs.

H. A. FRIEND AND COMPANY, INC.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

JOHN C. BREZINA
33 North Dearborn Street
Chicago, Illinois 60602
Attorney for Respondent

The Scheffer Press, Inc.—ANdover 3-6850

TABLE OF CONTENTS

	PAGE
JURISDICTION	1
QUESTIONS PRESENTED	3
STATEMENT OF THE CASE	4
ARGUMENT	7
ATTORNEY'S FEES	11
MISREPRESENTATIONS AS TO PAPER QUALITY	13
COMPUTATION OF DAMAGES	15

CASES CITED

Audio Fidelity, Inc. v. High Fidelity Recordings, Inc., 305 F. 2d 86, 134 USPQ 93 (9 Cir. 1962)	12
Bigelow v. RKO Radio Pictures, Inc., 327 U.S. 251, 66 S. Ct., 574, 580, 90 L. Ed. 652	16
Chamberlain v. Columbia Pictures, Corp., 186 F. 2d 923	15
Eastman Kodak Company v. Southern Photo Materials Company, 273 U.S. 359	16
Fleischmann Distilling Corp. v. Meier Brewing Co., 314 F. 2d 149	11, 12
Fleischmann Distilling Corp. v. Meier Brewing Co., 386 U.S. 714, 18 L. Ed. 2d 475, 87 S. Ct. 1404	11
Hesse v. Grossman, Cal. App. 313 P. 2d 625, 629 (1957)	14
McCord v. Plotnick, 108 Cal. App. 2d 392, 239 P. 2d 32 (1951)	14

PAGE

Meier Brewing Co. v. Fleischmann Distilling Corp., 359 F. 2d 156 (9 Cir. 1966) 11

Morales v. City of Galveston, 370 U.S. 165 16

National Van Lines, Inc. v. Dean, 237 F. 2d 688, 111 USPQ 165 (9 Cir. 1956) 12

Pecheur Lozenge Co. v. National Candy Co., Inc., 315 U.S. 666, 86 L. Ed. 1103, 62 Sup. Ct. 853 (1942) 371 6

Sprague v. Ticonic National Bank, 307 U.S. 161 (1939) 13

Story Parchment Co. v. Paterson Parchment Paper Co., 282 U.S. 555, 562, 563, 51 S. Ct., 248, 250, 75 L. Ed. 544 16

Textron Inc. v. Spi-Dell Watch and Jewelry Co., Inc., 406 F. 2d 544 12

Universal Pictures Co. v. Harold Lloyd Corporation, 162 F. 2d 354 (CA 9 1947), 15 U.S. § 1117 16

STATUTES

California Business and Professional Code § 3294 ....12, 13

California Civil Code § 17082 .....16, 17

Committee on Patents, Subcommittee on Trademarks, House of Representatives, 76 Cong. First Session on H.R. 4744 9

Lanham Act §§ 1125, 1126 9

Restatement of Torts 14

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1969

No. 941

FRIEND AND COMPANY
and WILBER H. FRIEND,

Petitioners,

vs.

H. A. FRIEND AND COMPANY, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

JURISDICTION

Jurisdiction of the lower courts in this case was stated by the Court of Appeals to be:

> ". . . based upon the Federal Trademark Act of 1946, the Lanham Act, 15 U.S.C. §1121 and upon 28 U.S.C. §1338. Diversity jurisdiction, 28 U.S.C. §1332, was

also alleged. On March 16, 1966, while that case was still pending, plaintiff appellee filed the second suit here appealed, charging appellant with misrepresentation and false advertising. Lanham Act and diversity jurisdiction were invoked. Jurisdiction in this court for the combined appeal and cross-appeal is based upon 15 U.S.C. §1121."

This is an action involving multiple issues falling in the field of unfair competition, some of which come within the scope of, and are proscribed by the Federal Trademark Act of 1946, the Lanham Act—and other issues based on difierent facts, which do not. The latter constitute independent causes of action for unfair competition at common law and which are also proscribed by statutes of the forum state, California. These non-Lanham Act causes of action provide substantial support for the decisions below on the points involved herein.

Petitioner has failed to comply with Rule 23 (1)(g) of this Court which requires a petitioner to state the jurisdictional basis for the decisions of the lower Federal Courts. Respondent does not point to this merely as a "technical" violation of the Rules but because this omission shows an effort to cover up the fundamental flaw in Petitioner's argument—the fact that there are substantial, independent, non-Lanham Act causes of action and diversity and pendent jurisdiction over those causes under 28 U.S.C. §1331 & 1338.

QUESTIONS PRESENTED

(1) In an action involving intentional and deliberate acts of unfair competition giving rise to both Lanham and non-Lanham Act causes of action, is an award of partial attorney's fees precluded under state law, solely because plaintiff receives some damages and injunctive relief under the Lanham Act for trademark infringement and misrepresentation of goods but where substantial relief is given for the independent acts of unfair competition under state law on the non-Lanham Act causes of action.

(2) Does the Lanham Act preclude granting of remedies under state law for all species and types of unfair competition other than the three species of unfair competition for which remedies are provided in the Lanham Act, infringement of a federally registered trademark, misrepresentation of the nature of goods, and rights arising under treaties or conventions with certain foreign nations.

(3) Is it proper for this Court to review construction of a statute whose terms are clear and unambiguous where the differences in results in different Courts of Appeals are due solely to factual differences in the respective cases.

(4) Is there any basis for Supreme Court review of the factual question of the amount of a damage award where the District Court had before it the evidence that defendant took business away from plaintiff by its misrepresentations and acts of unfair competition, including accounting records showing the quantity of purchases of such companies before and after the taking and where such findings were reviewed by and affirmed by the Court of Appeals.

STATEMENT OF THE CASE

Petitioner, in its zeal to pursuade this Court that this is purely a Lanham Act case, makes some rather astounding misstatements of what this case involves. On Page 9, Section I it makes the statement that this was a case

> "in which all relief was under the Lanham Act".

On Page 11, it states, below the quote in the middle of the page,

> "in the present cases, the entire judgment was within the Lanham Act, namely the injunction against infringement of the trademarks 'Friends', 'Barrister Bond' and 'Banner' ".

The falsity can be demonstrated by a reading of the decisions of the Courts below and more specifically the Judgment of the District Court, reproduced at Pages A43-A45 in the Appendix attached to the Petition herein. Sections 1(a)(2), 1(c) and 1(d) have nothing to do with the Lanham Act and are based on state common law and statutes proscribing other types of unfair competition.

The same is clear from a reading of Petitioner's "Concise Statement of the Case". On Page 5 of Petitioner's brief, the second paragraph lists the trademarks which were infringed, and clearly concedes that "Banner" is an *unregistered* mark and concludes with the sentence "Other causes of action presented are not material to the matters presented here". These "other causes of action" relate to Petitioner's multi-faceted campaign of unfair trade practices separate from the issues of infringement of registered trademarks under the Lanham Act and not only are material here but are the very basis of the rulings of the lower courts being challenged by Petitioner.

As is apparent from the title of the case, one of the primary issues is unfair competition by use of a confusingly similar trade name (company name). Other non-Lanham Act issues include false representations in catalogs, and promotional materials, such as putting the words "Western Division" after Petitioner's name, when it had only one place of business in California; using the phrases such as "since 1908" and "In business in every state since 1908" when these statements were true only of Respondent; using a map of the United States in its catalog showing an asterisk in the area of Chicago, Illinois, where Respondent is located and referring to it as Petitioner's "General Offices" when it had no place of business other than California, and many other acts of unfair competition, including the infringement of Respondent's common law trademark, "Banner", most of which are set forth in the portion of the District Court's decision entitled "Unfair Competition", (Petitioner's Appendix beginning at page A26).

In addition, there were many oral misrepresentations by Wilber Friend which deceived customers of Respondent to believe that Petitioner was a part of, or affiliated with Respondent and which resulted in business being taken away from Respondent.

Petitioner's program of unfair trade practices was not only deliberate and intentional but was malicious. In one transaction, Petitioner, Wilber Friend, corresponded with a law firm in Tucson, Arizona, which was buying from both parties, thinking they were the same organization. The secretary ordered some products from Petitioner and asked for a quotation on business cards, which they had theretofore obtained from Respondent. Wilber wrote the secretary quoting a price for the cards and said there would be an additional charge of $10.00 for the engraving die. The secretary wrote back saying they already had

an engraving die at "the Zion, Illinois branch of your organization" and suggested that Wilber get the die from "Zion" or, alternatively, she could order the cards from "Zion". In a deliberate effort to mislead the customer and to take over this business, Wilber wrote back falsely stating that he was obtaining the die from the "Zion branch", made a new die himself at his own expense, and filed the order. (RT 106, EX 207, RT 111, 151)

Respondent is aware that this Court is primarily concerned with fundamental and important issues of law and not evidentiary details. However, respondent relates the facts to demonstrate what issues and causes of action were in this case and therefore what questions of law really were present which formed the basis for the decision of the lower Courts. Plainly and simply, there were substantial causes of action and issues of unfair competition separate from the Lanham Act causes of action and issues, which the lower courts properly decided under California law of unfair competition. *Pecheur Lozenge Co.* v. *National Candy Co., Inc.,* 315 U.S. 666, 86 LEd 1103, 62 Sup.Ct. 853 (1942), 371.

The only relationship of the Lanham Act issues to the unfair competition issues described above and in the decisions of the lower courts is that they form a part of a malicious and deliberate plan to trade on Respondent's goodwill.

Petitioner has not appealed the major injunctive provision. Petitioner's real motives in seeking this writ are plain—Wilber Friend has cheated and defrauded his family, his business partners, and his customers for over two decades. He has now been caught and it galls this clever commercial pirate, who no doubt derived great perverse satisfaction from "taking" the legal profession, to now have to pay out some of his ill gotten gains.

ARGUMENT

Petitioner's arguments, reduced to its essence is, that because Congress passed the Lanham Act all state law of unfair competition, both common law and statutory, simply ceased to exist. According to Petitioner, this would be true not only as to causes of action under state law based on the same facts as the Lanham Act cause of action, but on all causes of action involving acts of unfair competition having no relationship to the facts or remedies to which the Lanham Act relates.

Congress, in passing the Lanham Act, was fully aware that the law of unfair competition was far broader in scope than the subject matter to which the Lanham Act related. In the Senate report to the 79th Congress, second session, dated May 14, 1946, it was stated:

> There is no essential difference between trade-mark infringement and what is loosely called unfair competition. Unfair competition is the genus of which trade-mark infringement is one of the species; "the law of trade-marks is but a part of the broader law of unfair competition" (*United Drug Co.* v. *Rectanus,* 248 U. S. 90, 97). All trade-mark cases are cases of unfair competition and involve the same legal wrong. As Mr. Justice Pitney observed in *Hanover Star Milling Co.* v. *Metcalf* (240 U. S. 403, 412):
>
> The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another. * * *
>
> This essential element is the same in trade-mark cases as in cases of unfair competition unaccompanied with trade-mark infringement.
>
> The protection accorded trade-marks is merely protection against swindling.

In contrast to petitioner's erroneous statement (see petitioners brief p. 17), the purposes of the Lanham Act were stated on page 5 of the same report:

> This bill attempts to accomplish these various things:
>
> 1. To put all existing *trade-mark* statutes in a single piece of legislation.
>
> 2. To carry out by statute our international commitments to the end that American traders in foreign countries may secure the protection to their *marks* to which they are entitled. Although it has solemnly pledged at inter-American conventions to do so, the United States has failed adequately to protect owners of *trade-marks* in the other American countries doing business with this country. As a result of this inaction, our business organizations have not received reciprocal advantages in the other Americas. The bill remedies this matter, eliminates these sources of friction with our Latin-American friends, and will facilitate mutual trade in this hemisphere. These features make this bill of primary importance now.
>
> 3. To modernize the *trade-mark* statutes so that they will conform to legitimate present-day business practice.
>
> 4. To remedy constructions of the present acts which have in several instances obscured and perverted their original purpose. These constructions have become so ingrained that the only way to change them is by legislation.
>
> 5. Generally to simplify *trade-mark* practice, to secure trade-mark owners in the goodwill which they have built up, and to protect the public from imposition by the use of counterfeit and imitated marks and false trade descriptions. (emphasis added)

Obviously the remedies provided in sections 33-36 inclusive, (15 U.S.C. §1114-1118) relate to claims of infringement of trademarks registered under the act. In addition, there are two categories of tortious acts of unfair competition for which civil liability is defined by the act. Section 43 (15 U.S.C. §1125) is entitled "False Designations of Origin and False Descriptions Forbidden", and section 44, (15 U.S.C. §1126), applies to rights of nationals of foreign countries which have treaties with the United States, giving them under certain conditions rights relating to "trade or commercial names, or the repression of unfair competition" and gives United States citizens reciprocal rights to those of the nationals or foreign countries defined by section 44(b).

While section 44 speaks in terms of unfair competition, it is, by its expressed terms, limited to situations tied in with persons entitled to assert claims under certain treaties or conventions with foreign countries.

The comment of Mr. Lanham on section 45, later becoming section 44, following the printed section of the bill, also on page 163 was as follows:

> "Title IX has to do with the International Convention, and that is all included within one section, so we will consider that title in its entirety. Are there any suggestions with reference to title IX?"

It is clear from the history of the congressional proceedings which led up to the passage of the Lanham Act that Congress never intended to provide for a federal law covering all acts of unfair competition. In the report of the hearing before the *Committee on Patent, Subcommittee on Trademarks, House of Representatives,* Seventy-Sixth Congress, First Session on H. R. 4744 a. predecessor bill, dated March 28-30, 1939, is set forth at

page 163, the predecessor section to what ultimately became section 44 of the Lanham Act appears. It had a subsection G, which then preceded what is now section 44(i) of the Lanham Act, which read as follows:

> "(g). All acts of unfair competition in commerce are declared to be unlawful and the provisions of section 32 to 35 inclusive shall be applicable thereto."

It is obvious from a comparison of the bill as it stood in 1939 with the Lanham Act section 44 as passed, that Congress deleted the above quoted section (g) relating to "all acts of unfair competition" and therefore limited it to unfair competition relating to national treaties and conventions. A reading of the comments indicated that the reason for ultimate deletion of the prohibition of "all unfair competition" was that it was too vague, difficult in definition and represented many difficult jurisdictional problems. A leading lawyer in the field of unfair competition, Mr. Rogers, commented in response to a proposed definition of unfair competition at page 165 of the above transcript as follows:

> "Now perhaps some place could be found for an added section to give Mr. Byerly's very excellent definition of unfair competition. The difficulty is however that unfair competition is what Louis Carroll used to like to call a 'portmanteau' word—it means a lot of things, and it means different things to different people, and the minute you attempt to define it you limit it, just as you limit 'fraud' when you attempt to define it."

Certainly to accept petitioner's position that the fact Congress passed the trademark Lanham Act precluded application of any state unfair competition laws on unfair competition causes of action independent of those of which remedies are provided by the Lanham Act, would

be to say that Congress pre-empted the field of unfair competition by accident. It is believed the essence of pre-emption is a clear showing of deliberate intent to pre-empt by the Congress. The terms and history of the Lanham Act rebut any such contention.

ATTORNEY'S FEES

Petitioner's points 1, 2, and 3 attack the District Court's allowance of $30,000 in attorney's fees, which is approximately one half of the attorney's fees and litigation expenses actually incurred. (CT 454-458) As previously pointed out, there are substantial independent causes of action in this case having nothing to do with the Lanham Act, the determination of which are controlled by California law, which is the basis for allowing attorney's fees. In order to spur the court into reviewing the decisions of the courts below, petitioner speaks in terms of the lower court "overcoming" the rule of the *Fleischmann* case on attorney's fees. (*Fleischmann Distilling Corp.* v. *Maier Brewing Corp.*, 359 F.2d 156, aff'd 386 U.S. 714, 18 L.Ed. 2d 475, 87 S.Ct. 1404) The Court of Appeals that decided this case was the same Court of Appeals that decided the *Fleischmann* case en banc disallowing attorney's fees under the Lanham Act, which was later affirmed by this Court. The Court of Appeals was perfectly aware of the nature and extent of the holding of the *Fleischmann* case, and it recognized in this case that it would have been incorrect to allow attorney's fees under the Lanham Act. However, this does not mean that attorney's fees could not be awarded under California law in a case which had substantial, independent causes of action under California law.

The *Fleischmann* case necessarily was limited to a pure Lanham Act issue. The first appeal in the *Fleisch-*

mann case, (*Fleischmann Distilling Corp.* v. *Maier Brewing Corp.*, 314 F2d 149) was from a judgment by the District Court for the *defendants* finding no trademark infringement or unfair competition. The Court of Appeals found that there was infringement under the Lanham Act only. Summarizing its conclusion on the first appeal, the court stated at 314 F.2d 161:

> "And because we have found adequate legal support for our conclusion in the Lanham Act, we do not consider here the appellants' argument that the California law, statutory and decisional, compels the same conclusion."

If there was any doubt that the issues of unfair competition and California law were judicially excised before the matter of attorney's fees came up, this court made it plain that certiorari was granted to construe a particular section of the Lanham Act. The *Textron* case (*Textron, Inc.* v. *Spi-Dell Watch and Jewelry Co., Inc.*, 406 F.2d 544) cited by petitioner was simply one where the trademark issues under the Lanham Act and the unfair competition issues were based on the same cause of action, that is, on the same set of facts, or one where the court did not believe that attorney's fees could be allowed under the applicable state law.

It is clear that the Court of Appeals below in this case affirmed the allowance of attorney's fees because there were substantial non Lanham Act causes of action, following its decision in *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 305 F.2d 86, 134 USPQ 93 (9 Cir. 1962), and *National Van Lines, Inc.* v. *Dean*, 237 F.2d 688, 111 USPQ 165 (9 Cir. 1956). It is also clear from the decisions of the District Court and the Court of Appeals that the California statute cited by the Court of Appeals, Section 17082 of the *California Business and Professional*

Code was an independent basis for allowing attorney's fees, but not the sole ground for allowing such attorney's fees under California law. The reference to §17082 could have been deleted and the Court of Appeals statement of California law would still be correct.

In *Sprague* v. *Ticonic National Bank,* 307 U.S. 161 (1939), this court allowed attorney's fees to be granted a successful party in a case of variation of "common fund" situation, that is, where the party receiving the attorney's fees successfully established a precedent which could be used by others having a similar claim against the defendant. This situation is present here because in establishing that this petitioner defrauded its customers by paper cheating, whether it be considered a violation of the Lanham Act or California statute or common law which all proscribe the same acts, forms a basis on which these customers, and competitors of Petitioner could recover. The frauds committed on its customers by Petitioner taken individually, are relatively small in dollar amount and would not justify court litigation to recover for the fraud in absence of such precedent. Further, some of Petitioner's customers who were defrauded where governmental bodies, such as Maricopa County, Arizona, which purchased stationery for all of the State Court Judges from petitioner and are thus put in an advantageous position by reason of the precedent which would make it much easier for this governmental body to recover from petitioner.

Misrepresentations as to Paper Quality

Both parties sold paper and stationery primarily to law offices and both relied heavily on catalogs, describing the paper, letter head, etc., and containing samples thereof. Both parties did most of their business by mail. For at

least 10 years petitioner was defrauding its customers and unfairly competing with respondent and others by furnishing lower grades of paper than represented in its catalog. In petitioner's catalog, "Barrister Bond" was represented to be 100% cotton fibre paper and stationery. (Respondent also used the same mark for over forty years to identify its 100% cotton fibre line). When one of petitioner's customers ordered "Barrister Bond" letterhead and matching envelopes, the letterhead was 100% cotton fibre, but the envelopes were made of 25% cotton fibre paper, which cost petitioner one half the price of 100% cotton fibre paper. The "Barrister Onionskin" was 75% cotton fibre paper.

Petitioner's line of office and letterhead paper sold under the "Title Linen" mark was represented in the catalog to be 50% cotton fibre. With the exception of two small purchases of 50% cotton fibre, amounting to less than two per cent of its purchases, all of the "Title Linen" paper delivered to petitioner's customers was 25% cotton fibre paper. Petitioner paid about 25% less for the 25% cotton fibre paper than the 50%. Petitioner's "Title Linen" envelopes were substantially all of "sulphite" grade on which petitioner saved considerably more than 25% in paper costs. See the District Court's Memorandum of Decision at pp. A35-A38 of the Petition herein.

The courts below found that this constituted a misrepresentation which came within the misrepresentations proscribed by section 43(a) of the Lanham Act 15 U.S.C. 1125(a). Misrepresentations of this sort are also actionable at common law, and under California statute. *Restatement of Torts,* section 761, *Hesse* v. *Grossman,* Cal. App. 313 P. 2d 625, 629 (1957), *McCord* v. *Plotnick,* 108 Cal. App. 2d 392, 239 P. 2d 32 (1951).

Petitioner claims there is a conflict between circuits as to this section of the Lanham Act in that some circuits

require showing of "passing off" in order to give relief under section 43(a) and others do not. These arguments do not appear to be of any consequence here because:

(a) The alleged "conflicts" are merely different results because the decisions are based on substantially different fact situations;

(b) The court's statement as to passing off in the *Chamberlain* case (*Chamberlain* v. *Columbia Pictures Corp.*, 186 F.2d 923) was dicta and even if it wasn't dicta, the Court of Appeals did not follow *Chamberlain* in this case; and

(c) While not mentioned by the Courts below because it was unnecessary, there is abundant evidence of passing off in this case, i.e., substituting the goods of one trader for those of another, to support a finding that there was "passing off" as a matter of fact.

Computation of Damages

In attacking the District Court's computation of damages, petitioner is, of course, attacking in this court findings of fact. On page 27 of its brief, petitioner states that "there is no evidence as to how much business these two diverted customers or any other customers gave to petitioners". This statement is completely false. In the first place, substantially all of the 30 confusion witnesses whose depositions were in the record and are referred to on page 27 of petitioner's brief, plus a witness who testified in court, were customers of Respondent who, because they were confused shifted their business over to Petitioner. Furthermore, there was voluminous documentary evidence in the form of letters, orders and customer ledger sheets showing the quantum of business done by these customers e.g., trial record, pgs. 305, 306; ex. 308, 309, both when they were doing business with Respondent and later when they did

business with petitioner. From these records and Wilber Friend's own testimony as to markups and profits, it was a relatively simple matter for the District Court to compute lost sales. Petitioner has shown nothing to demonstrate that the Court findings were clearly erroneous. See *Morales* v. *City of Galveston,* 370 U.S. 165, 168 (1961).

On the matter of determination of damages due to injury to Respondent's business reputation, it is clear that Petitioner was using respondent's trademark, a confusingly similar trade name and committing numerous other acts attempting to tie itself in with Respondent, all while it was cheating on paper quality. The fact of damage can be clearly inferred from this situation, but it also has been specifically shown on the record. Mrs. Muriel Leder testified that she bought paper and stationery for a relatively large law firm in Albuquerque, New Mexico from respondent after petitioner, Wilber Friend, called on her and misrepresented that he was the Western Division of respondent along with the use of confusingly similar literature, marks, etc.. Thinking she was dealing with Respondents "Western Division," she gave one order to Wilber Friend. She testified that after she was dissatisfied with the petitioner's products, she ceased to do business with *both* petitioner and respondent because of the dissatisfaction. (EX 250, RT 196)

The damage awards it clearly proper under principles set forth in *Story Parchment Co.* v. *Paterson Parchment Paper Co.,* 282 U.S. 555, 562, 563, 51 S.Ct., 248, 250, 75 L. Ed. 544; *Bigelow* v. *RKO Radio Pictures, Inc.,* 327 U.S. 251, 66 S.Ct. 574, 580, 90 L. Ed., 652; *Eastman Kodak Company* v. *Southern Photo Materials Company,* 273 U.S. 359; see also *Universal Pictures Co.* v. *Harold Lloyd Corporation,* 162 F.2d 354 CA 9 1947), 15 U.S. section 1117. Further, Section 3294 of the *California*

Civil Code allows a court to assess damages it determines appropriate apart from any actual damages in cases involving oppression, fraud or malice, express or implied.

It is also respectfully submitted that damages be assessed petitioner pursuant to Rule 56(4) of this court because of petitioner's obvious filing of this petition for delay and arguing of matters lacking real substance, as evidenced, among other things, by its misstating and omission of salient facts relating to the case and the nature of the decisions below. It would appear to be appropriate to remand to the District Court for assessment of the damages due to delay because, at a hearing before the District Court on December 29, 1969, the District Court indicated it might be favorably disposed to grant a motion finding petitioner in contempt based on documentary evidence showing that petitioner has continued to refer to, during the pendency of the appeals, the catalogs bearing the infringing trademarks, misrepresentations as to paper quality, etc., described in the District Court's decision. Petitioner has never prepared or sent out a replacement catalog for the infringing catalogs in the approximately 2 years since the decision of the District Court. An appropriate motion will be filed and heard shortly in the District Court. For the foregoing reasons it is respectfully requested that the Petition for Writ of Certiorari be denied.

Respectfully submitted,

JOHN C. BREZINA
33 North Dearborn Street
Chicago, Illinois 60602
Attorney for Respondent